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10/648,091	08/26/2003	Kenji Yamasaki	450100-04699	2766

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EXAMINER	
CHIO, TAT CHI	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/648,091	Applicant(s) YAMASAKI, KENJI	
	Examiner Tat Chi Chio	Art Unit 2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-17* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,4-9 and 12-17* is/are rejected.

7)☒ Claim(s) *2,3,10 and 11* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *8/27/2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *1/23/2004*.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 17 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

> Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works, and a compilation or mere arrangement of data.
>
> Both types of "descriptive material" are nonstatutory when claimed as descriptive material per se, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare In re Lowry, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994)(discussing patentable weight of data structure limitations in the context of a statutory claim to a data structure stored on a computer readable medium that increases computer efficiency) and Warmerdam, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory).
>
> In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See Lowry, 32 F.3d at 1583-84, 32 USPQ2d at 1035.

Claim 17 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory matter as follows. Claim 17 defines a program embodying functional descriptive material. However, the claim does not define a computer-readable medium or memory and is thus non-statutory for that reason (i.e., "When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most

cases since use of technology permits the function of descriptive material to be realized"). That is, the scope of the presently claimed a program can range from paper on which the program is written, to a program simply contemplated and memorized by a person. The examiner suggests amending the claim to embody the program on "computer-readable medium" in order to make the claim statutory. Any amendment to the claim should be commensurate with its corresponding disclosure.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1, 4, 5, 8, 9, 12, 13, 16, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yun (5,771,329) in view of Hogan (US 6,195,726 B1).

Consider claims 1, 9, and 17, Yun teaches a data processing apparatus comprising: a recorder for recording content data onto a recording medium; and a controller (40 of Fig. 1) for controlling said recorder such that when, after first timing in which user instruction information indicating a first instruction to pause or stop recording of said content data is received from a user during recording of said content data onto said recording medium, user instruction information indicating a second instruction to resume recording said content data is received in third timing before second timing that is timing a preset period after said first timing (Fig. 2), but Yun fails to explicitly teach

said content data corresponding to a period from said first timing to said third timing is recorded on said recording medium so as to be continuous with said content data before said first timing.

Hogan teaches said content data corresponding to a period from said first timing to said third timing is recorded on said recording medium so as to be continuous with said content data before said first timing (col. 2, lines 51-67). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to record content data corresponding to the period to allow a viewer to watch the content uninterrupted.

Consider claims 4 and 12, Yun and Hogan teach a data processing apparatus, wherein said controller controls said recorder to sequentially record said content data onto said recording medium (the system controller controls the recorder to recording mechanism driving section to record the data sequentially (before switching to another channel from the first channel and after switching back to the first channel) Fig. 1 of Yun and Fig. 2 of Yun); said controller controls said recorder such that when user instruction information indicating said second instruction is received within a period from said first timing during the recording of said content data onto said recording medium to said second timing, said content data corresponding to the period from said first timing to said third timing is retained on said recording medium (if the user wants the content recorded during the pausing period, the user is free to keep the content in the recording medium, col. 2, lines 51-67 of Hogan); and said controller controls said recorder such that when no user instruction information indicating said second instruction is received

within the period from said first timing during the recording of said content data onto said recording medium to said second timing, said content data corresponding to a period from said first timing to said second timing is erased from said recording medium (if the user does not want the content recorded during the pausing period, the user is free to erase it from the recording medium, col. 2, lines 51-67 of Hogan).

Consider claims 5 and 13, Yun and Hogan teach a data processing apparatus, wherein said controller controls said recorder such that when no user instruction information indicating said second instruction is received within the period from said first timing to said second timing, said content data itself corresponding to the period from said first timing to said second timing is erased from said recording medium (if the user does not want the content recorded during the pausing period, the user is free to erase it from the recording medium, col. 2, lines 51-67).

Consider claims 8 and 16, Hogan further teaches a data processing apparatus, further comprising an image pickup device for obtaining said content data (Fig. 5).

3. Claims 6, 7, 14, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yun (5,771,329) in view of Hogan (US 6,195,726 B1) as applied to claims 1, 4, 9, and 12 above, and further in view of Kondo (US 6,973,012 B2).

Consider claims 6 and 14, Yun and Hogan teach all the limitations in claims 1 and 4 but fail to teach a data processing apparatus, wherein when no user instruction information indicating said second instruction is received within the period from said first timing to said second timing, said controller treats said content data corresponding to the period from said first timing to said second timing as erased from said recording

medium by excluding said content data corresponding to the period from said first timing to said second timing from a play list used for reproduction of said content data recorded on said recording medium so that said content data corresponding to the period from said first timing to said second timing is erased from said recording medium.

Kondo teaches a data processing apparatus, wherein when no user instruction information indicating said second instruction is received within the period from said first timing to said second timing, said controller treats said content data corresponding to the period from said first timing to said second timing as erased from said recording medium by excluding said content data corresponding to the period from said first timing to said second timing from a play list used for reproduction of said content data recorded on said recording medium so that said content data corresponding to the period from said first timing to said second timing is erased from said recording medium (col. 13, lines 51-55). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include a erasing unit to erase unnecessary portion of the recording information that is not to be reproduced according to the play list.

Consider claims 7 and 15, Kondo further teaches a data processing apparatus, further comprising a generator for generating time information, wherein said controller records said time information in association with said content data onto said recording medium by said recorder (col. 8, lines 1-14).

Allowable Subject Matter

4. Claims 2, 3, 10, and 11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tat Chi Chio whose telephone number is (571) 272-9563. The examiner can normally be reached on Monday - Thursday 8:30 AM-6:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Tran can be reached on (571)-272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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